

<b>CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)</b>			Docket No.
Applicant(s): <b>Benzion LANDA, et al.</b>			UCT-A
Application No. 09/322,174	Filing Date May 28, 1999	Examiner GOODROW, J.	Group Art Unit 1756
Invention: <b>TONER MATERIAL AND METHOD UTILIZING SAME</b>			RECEIVED CENTRAL FAX CENTER SEP 22 2004
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P18/REV02

<b>TRANSMITTAL LETTER</b> (General - Patent Pending)				Docket No. UCT-A	
In Re Application Of: Benzion LANDA, et al.					
Application No. 09/322,174	Filing Date May 28, 1999	Examiner GOODROW, J	Customer No. 44909	Group Art Unit 1756	Confirmation No. 7616
Title: TONER MATERIAL AND METHOD UTILIZING SAME				RECEIVED CENTRAL FAX CENTER SEP 22 2004	
<u>COMMISSIONER FOR PATENTS:</u>					
Transmitted herewith is: Further After Final Office Action dated March 12, 2004					
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				Dated: September 22, 2004	
<i>Signature</i>					
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<div style="border-bottom: 1px solid black; margin-bottom: 5px;">I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] o. (Date)</div> <div style="border-bottom: 1px solid black; margin-bottom: 5px;">Signature of Person Mailing Correspondence</div> <div style="border-bottom: 1px solid black;">Typed or Printed Name of Person Mailing Correspondence</div>					
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL FAX CENTER

SEP 22 2004

Applicant: Benzion LANDA, et al.  
Serial Number: 09/322,174  
Filed: May 28, 1999  
For: TONER MATERIAL AND METHOD UTILIZING SAME  
Art Unit: 1756  
Examiner: GOODROW, J. L.

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**FURTHER AFTER FINAL OFFICE ACTION**

Sir:

Further to a Final Office Action dated March 12, 2004, and a telephone conversation with the Examiner of September 21, 2004, applicants are resubmitting a version of some of the remarks in the previous amendment after final, for further consideration. Applicants submit that in view of the exact translation of additional portions of Japanese patent 05-242721 which is relied on by the Examiner, the Examiner should reconsider the rejection of the claims and allow the claims. This partial exact translation was submitted with the previous response (after final).

In the final office action, the Examiner rejected claims 55-58, 65-67, 69-71, 73-75 and 77-82 under 35 U.S.C. §103(a) as being unpatentable over Japanese patent 05-242721 in view of Ray et al.

As to the additional translation of JP 05-242721, the Examiner has been relying on the machine translation of the reference in rejecting the claims. Since the JP machine translations are admittedly inaccurate and often impossible to understand, applicants requested that a Japanese associate translate relevant paragraphs (including those cited by the Examiner) of the reference.

With the additional partial translation of the JP reference in hand, applicants submit that the combination made by the Examiner is not *prima facie* obvious.

The Japanese reference teaches the use of a chargeable powder (toner) for use in producing printed circuits. (Paragraph [008]) The size of the *metal* particles defined in this reference is 0.5 microns. (Paragraph [0013]) As clearly stated in the object of the invention, the JP application is meant to solve the problems of uneven distribution of metal particles in the toner. (Paragraph [0005]) This uneven distribution causes breaks in the wiring pattern of the printed

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circuit (Paragraph [0007]) The use of fine metal particles is indicated in paragraph [0008] as solving this uneven distribution problem.

The Examiner suggests in the rejection that it would have been obvious to use the much larger flakes of the Ray reference in the toner of the JP reference. Applicants submit, however, that this combination, as indicated by the Examiner, is not *prima facie* obvious for two reasons. First, it goes against the clear teaching of the JP reference that *small* powder material is to be used, in order to assure good distribution. Second, it would defeat the entire purpose of the JP reference, which is to foster even distribution. Third, there is no reason given or understood for providing larger flakes in the JP reference, since the JP reference deals with printed circuit boards, for which there is no need for the visual effect that would com from larger flakes.

Furthermore, the Ray reference teaches the use of a coating process for the large metal flakes (rather than the provision of large flakes dispersed in a polymer particle), since as clearly stated at col. 7, lines 40-50, the use of normal processes of manufacture of the particles including the extrusion process and high shear mixing result in crushing of the metal flakes. *Thus, for the only part of Ray that teaches metal dispersed in a polymer as required by claim 1, the particle size is small. Ray shows no method for producing polymer particles with flakes of silver or gold dispersed in the polymer and teaches that it is impossible to do so by methods known to him. Ray teaches using large flakes only as coated individual flakes.*

It is noted that in the JP reference the smaller metal particles are dispersed in the polymer under pressure (paragraph [0015]) and then crushed in a cutter mill and a jet mill (paragraph [0016]). Thus, based on the similarity (with respect to the friability of the metal flakes) of the method used in the JP reference to those specifically indicated as being unsuitable in the Ray reference, there would not be an expectation that the JP method would result in the toner of the invention, even if there were some motivation for trying the combination proposed by the Examiner.

*The bottom line is that for gold and silver dispersed in a polymer both references teach that only small flakes can be used (or at least that this is what is left at the end of the process.*


Thus, the suggested combination has many of the indicators provided in MPEP §2143.01 and §2143.02 for a lack of *prima facie* obviousness. There is no motivation in combining the references as suggested by the Examiner, the proposed modification would render the primary prior art unsatisfactory for its purpose, the proposed modification would change the principle of operation of the primary reference and there would not be a reasonable expectation of success, since the resulting toner would not be suitable for the purpose intended.

Applicants submit that the present claims are patentable over the cited art. Applicants note

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that a Notice of Appeal has been filed in the present application and that the next date for filing the appeal brief is in mid October. A notice of allowance or an additional advisory action is respectfully requested to allow the applicants to prepare the brief.

Respectfully submitted,  
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September 22, 2004  
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